

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)	
)	
Yisroel Leftkowitz)	
)	
Serial No.: 09/729,984)	Group Art Unit: 3688
)	
Filed: December 5, 2000)	Examiner: Raquel Alvarez
)	
For: METHOD AND APPARATUS)	
FOR SELLING INTERNATIONAL)	
TRAVEL TICKETS IN COMBINATION)	
WITH DUTY FREE GOODS)	

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

In support of the Notice of Appeal filed on June 30, 2009, and pursuant to 37 C.F.R. § 41.37, Appellant present this appeal brief in the above-captioned application.

This is an appeal to the Board of Patent Appeals and Interferences from the Examiner's final rejection of claims 1-2, 4-12, 14-20, 85, 96-102, 104-105 and 108 in the Final Office Action dated May 20, 2009. The appealed claims are set forth in the attached Claims Appendix.

Appellant submits the present Appeal Brief is in complete compliance with the formal requirements of 37 CFR 41.37 and any Patent Appeal Specialist lacks valid grounds for rendering the present Appeal Brief as being non-compliant. In the event the present Appeal Brief is deemed non-compliant, Appellant demands complete

clarity of the grounds of such non-compliance, as well as explicit instructions for curing any such interpreted defect. Appellant seeks to advance the substantive appeal of the present patent application and seek to forward such substantive examination in lieu of any formalistic matters as rendered by the Patent Appeals Specialist to delay the Examination of the present Appeal.

1. Real Party in Interest

This application is the real party in interest.

2. Related Appeals and Interferences

There are no other appeals or interferences which would directly affect, be directly affected by, or have a bearing on the instant appeal.

3. Status of Claims

Claims 1-2, 4-12, 14-20, 85, 96-102, 104-105 and 108 are currently pending. Claims 1-2, 4-12, 14-20, 85, 96-102, 104-105 and 108 are rejected. Claims 3, 13, 21-84, 103, 106-107 and 109-110 are cancelled. Claims 86-95 are withdrawn.

The rejection of claims 1-2, 4-12, 14-20, 85, 96-102, 104-105 and 108 is being appealed.

Claims 1-2, 4-5, 7-12, 14-15, 17-19, 85, 96-102, 104-105 and 108 stand rejected under 35 U.S.C. §103(a) based on an obvious combination of U.S. Patent No. 6,847,965 (“Walker”) in combination with Business Wire article (“Air France”). Claims 6 and 16 stand rejected under 35 U.S.C. §103(a) based on an obvious combination of Walker with Air France with third reference, the article “Golden Boutique Set to Boost MAS Revenue” (“Ong-Yeoh”). There are not listed grounds in the final Office Action for the final rejection of claim 20.

4. Status of Amendments

All amendments submitted by the Appellant have been entered.

5. Summary of Claimed Subject Matter

Appellant initially notes, as a preliminary matter, that §5 herein provides a summary of the claimed subject matter of Independent claims 1, 11 and 96 consistent with 37 C.F.R. §41.37(c)(1)(v). Appellant note that §§6 and 7 include separate headings for dependent claims 6, 16 and 20, but submit that these dependent claims are not “argued separately under the provisions of paragraph (c)(1)(vi)” and therefore the present §5, in noting the Independent claims, is in proper compliance.

For clarity, the following claimed subject matter is designated with reference to the Paragraph numbering of the Published Application 2001/0037250.

Claim 1 recites a method of selling international travel tickets in combination with duty free items from a single merchant (§ [0017]), comprising the steps of offering to sell to a customer, over a computer network (§ [0044]), a specific international travel ticket for travel with a first passenger carrier at a discounted price (§ [0017]) and one or more specific duty free items (§ [0017]), in conjunction with said offer to sell said specific international travel ticket at said discounted price (§ [0017]), requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item selected from a group of one or more specific duty free items (§ [0053]), the at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier during the travel associated with the specific international travel ticket said merchant having arranged with the first passenger carrier for delivery of the at least one specific duty free item to said

customer during the travel associated with said specific international travel ticket (§ [0057]) without the merchant being required to pay at least a portion of a concession fee otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items (§ [0028]), said merchant acknowledging said customer's decision to purchase said specific international travel ticket and said at least one specific duty free item (§ [0058]), the acknowledgment being made over said computer network (§ [0058]), said merchant accepting payment over said computer network from said customer for said specific international travel ticket and said specific duty free item (§ [0057]), said merchant delivering said specific international travel ticket to said customer (§ [0056]), and said merchant advising said customer of the method of delivery of said specific duty free item to said customer (§ [0054]), said method of delivery being connected to said customer engaging in the international travel associated with said specific international travel ticket (§ [0054]), wherein said merchant determines the discounted price of said specific international travel ticket based at least in part on a dollar value of one or more duty free items (§ [0030]) which are or must be purchased from the merchant such that the portion of the concession fee not paid by the merchant on the dollar value is sufficient to allow the merchant to sell the specific international ticket at the discounted price (§ [0028]).

Claim 11 recites a method of selling duty free items in combination with international travel tickets from a single merchant (§ [0017]), comprising offering to sell to a customer, over a computer network (§ [0044]), at least one of a plurality of specific duty free items at an offering price (§ [0020]), in conjunction with said offer to sell said at least one specific duty free item at said offering price, requiring said customer to select

for purchase as part of a single transaction both the specific duty free item and at least one specific international travel ticket to be selected from the group of one or more specific international travel tickets (§ [0053]), the at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier during the travel associated with said at least one-specific international travel ticket said merchant having arranged with the first passenger carrier for delivery of the at least one specific duty free item to said customer during the travel associated with said at least one specific international travel ticket (§ [0057]) without the merchant being required to pay at least a portion of a concession fee otherwise charged by the passenger carrier to merchants for selling or delivering such duty free items (§ [0028]), said merchant acknowledging said customer's decision to purchase said at least one specific duty free item and said at least one specific international travel ticket (§ [0058]), the acknowledgment being made over said computer network (§ [0058]), said merchant accepting payment over said computer network from said customer for said at least one specific duty free item (§ [0057]), said merchant advising said customer of the method of delivery of said at least one specific duty free item to said customer (§ [0054]), said method of delivery being connected to said customer engaging in the international travel associated with said at least one specific international travel ticket (§ [0054]), and delivering said at least one specific international travel ticket to said customer (§ [0056]), wherein said merchant determines the offering price of said at least one specific duty free item such that the portion of the concession fee not paid by the merchant on the offering price is sufficient to allow the merchant to sell the specific international travel ticket (§ [0028]).

Claim 96 recites a computer implemented method for offering a combination of an international travel ticket and a duty free item to a consumer (§ [0017]), the method comprising offering a plurality of international travel tickets and a plurality of duty free items to a customer (§ [0017]), allowing the customer to select at least one of the international travel tickets for travel on a first passenger carrier or at least one of the duty free items for purchase (§ [0053]), if the customer has selected at least one of the international travel tickets, requiring the customer to select at least one of the duty free items to obtain in combination with the selected international travel ticket at a first price (§ [0024]), if the customer has selected at least one of the duty free items, requiring the customer to select at least one of the international travel tickets to obtain in combination with the selected duty free item at a second price (§ [0029]), selling the at least one selected international travel tickets and the at least one selected duty free items to the customer in a single transaction (§ [0053]), and arranging for delivery of the at least one selected duty free items to the customer in association with the customer's travel using the at least one selected international travel tickets at or near an exit point or on board the first passenger carrier (§ [0057]), wherein the first price and the second price are each determined such that at least a portion of a concession fee otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items is not included in the first and second prices (§ [0026]).

6. Grounds of Rejection to be Reviewed on Appeal

Appellant respectfully requests that the following grounds of rejection be reviewed on appeal:

I. Claims 1-2, 4-5, 7-12, 14-15, 17-19, 85, 96-102, 104-105 and 108 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in combination with Air France.

II. Claims 6 and 16 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in combination with Air France in combination with Ong-Yeoh.

III. Claim 20 is not properly rejected as the Examiner fails to give grounds of rejections.

7. Argument

I. Claims 1-2, 4-5, 7-12, 14-15, 17-19, 8, 96-102, 104-105 and 108 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in combination with Air France.

The present prosecution has endured a lengthy and circuitous examination. Appellant engages the Appeal process to seek resolution not available through direct engagement with the Patent Examiner Alvarez. Appellant notes multiple concerns providing, in its totality, the allowability of the presently-pending claims as well as conditions to the patent examination having endured almost nine full years since the original filing date of December 5, 2000.

A. No Response to Arguments in non-final Office Action dated September 11, 2009

In response to the Office Action dated December 28, 2007, Appellant filed a Preliminary Amendment with a Request for Continued Examination, amending the pending claims. In response thereto, a non-final Office Action was mailed September 1, 2008. Beginning on page 5 of that Office Action, the Examiner states “Applicant’s arguments ... have been considered but are moot in view of the new ground(s) of rejection.”

Appellant asserts confusion because there is no new “ground(s) of rejection.” In fact, the pending claims are rejected under the same identical grounds as before, the

Walker / Air France combination. On page 14 of the Preliminary Amendment, Appellant asserted:

Nothing in the prior art recognizes this opportunity for synergy. The Examiner relies on Walker as showing the traditional “buy one get one free” model. Walker does not however, show a specific pricing determination for one or both items based on the savings of all or a portion of a concession fee charged by a passenger carrier for the sale or delivery of a duty free item.

Appellant asserts confusion as to the Examiner’s omission to address this position. Appellant, in continuing the prosecution of the pending application submitted claim amendments in a Preliminary Amendment in conjunction with a Request for Continued Examination, paying additional fees for the continued examination. Appellant did not receive that examination because Appellant’s position has not been given consideration. Rather, the Examiner asserts the broad position that this position is “moot,” which is clearly incorrect.

Appellant re-iterates the above position regarding the failure of the prior art to recognize an opportunity for synergy and that Walker’s “buy one get one free” fails to teach or suggest a specific pricing determination for one or both items based on the savings of all or a portion of a concession fee charged by a passenger carrier for the sale or delivery of a duty free item.

In the Response to Arguments section, beginning on page 5 of the final Office Action (dated May 20, 2009), ¶8, the Examiner asserts that the arguments were moot because of the Examiner’s blanket reliance on “Official Notice.” Appellant must respectfully disagree, as this utterly fails to advance the prosecution and provides no indication for Appellant understanding and cogently responding to reasons for the pending claims being rejected.

As noted further below, Appellant submits the Examiner improperly relies too much on the blanket assertion of “Official Notice,” overlooking the **exact** language of the claims. Appellant submit that exact wording of the claims and exact scope of the claimed invention is overlooked, which is further supported by the Examiner’s failure to expressly state support in the Response to Arguments section. Stated another way, Appellant prepared, filed and paid for a Preliminary Amendment with a Request for Continued Examination, including amending the claims and further arguments supporting the patentability of the pending claims, to which Appellant receive no indication as to why the **exact-same** rejection was presented to the newly-amended claims and the arguments were dismissed.

B. The Examiner makes an improper leap from “discount” on duty free items to the recited limitations

On page 3 of the September 11, 2008 Office Action, the Examiner states:

With respect to the first item being an international travel ticket and the second item being a duty free item. Air France teaches customer purchasing an international ticket being offered discounts for duty free items. It would have been obvious to a person of ordinary skill in the art at the time of Applicant’s invention to have included in the invention of Walker international tickets and duty free items in order to motivate customer to buy international flights.

Appellant asserts confusion because the Examiner makes an improper leap from the generalized notion of the “buy one get one free” concept of Walker and the duty free discount concept of Air France to the recited “offering to sell a customer, over a computer network, a specific international travel ticket for travel with a first passenger carrier at a discounted price and one or more specific duty free items.”

As a preliminary matter, Appellant first notes for the Board that Walker relates to a camera and database application for photographing license plates of cars at fast food

drive-thru windows. In the Walker system, the drive-thru orders are cataloged relative to the license plates, creating a database record of a user's purchasing habits. Then, using processing logic, when the individual returns to the drive-thru window, this previous-purchase data is mined to offer user-specific deals, such as the buy-one-get-one-free promotion. While listed as a primary reference in the present 103(a) rejection, Walker is asserted, as best understood, for the singular notion of "buy-one-get-one-free." The divergent nature of the Walker system compared to the claimed present invention further expand the absurdity of the assertion that Appellant is prohibit from obtaining patentable protection because one skilled in the art would have "obviously" combined this drive-thru window technology and the Air France article that mentions the terms "duty free."

The Air France article states the basic notion that if a person purchases the \$428 fare, they will receive a bunch of items as part of the "welcome bonus," including a "shopping discount voucher" at a duty free shop. Stated another way, the Air France reference "teaches" that if you buy one item, you get a second item for free, that second item is a coupon for a discount at another store. At best, Air France modifies the buy one get one free concept of Walker. Under the Air France system, the bought "one" is not the same as the free "one," instead the bought "one" is a plane ticket and the free "one" is a discount voucher, which necessarily requires the person to make another purchase to realize any benefit of the airline ticket purchase.

The Examiner's assertions in upholding the present rejection ignores the **exact** language of the claim, including the language of "offering to sell ... a specific international travel ticket ... and one or more specific duty free items." There is no teaching of Air France for the sale of a duty free item. At best, Air France offers the

customer a discount voucher in combination with the purchase of the economy-fare airline ticket.

For further differentiation, under the Air France teaching, the customer purchases the airline ticket and then must make another, separate purchase to take advantage of the discount voucher. The free giveaway of a discount voucher, in no way shape or form, teaches or suggests “offering to sell a customer, over a computer network, a specific international travel ticket for travel with a first passenger carrier at a discounted price and one or more specific duty free items.” (emphasis added)

For further illustration, the claimed invention provides that a person receives an offer for an airline ticket and a duty free item. Therefore, in a single transaction, the person obtains both the ticket and the airline ticket, for the purchase price. In the Air France system, the person purchases the airline ticket at the \$428 price and then receives a voucher. To use the voucher, the person then must travel to a duty free shop (which may or may not be convenient for the user), the person then must make another purchase, spending more money to use the voucher, thus requiring two separate sales transactions and additional costs beyond the airline ticket, the additional cost associated with the time/money to find the duty free shop and the cost to use the voucher.

Therefore, there is no reasonable leap to assert that “It would have been obvious ... to have included ... international tickets and duty free items in order to motivate customer to buy international flights.” Stated succinctly, Air France does **not** teach or suggest the sale of a duty free item with an airline ticket. Rather, Air France teaches the offer of a discount voucher that can be used to then purchase a duty free item. It is

improper to make the assumption that Air France teaches the sale of **both** an airline ticket and a duty free item.

Under the Air France system, the customer must make an additional purchase to realize the same benefits recited under the claimed invention. The combined systems of Walker and Air France would provide hidden or stealth costs, proving extremely unfair to customers. As recited, the customer is offered both the airline ticket and a duty free item. This is significantly separate and distinct from the Air France / Walker combination which would require the customer to purchase the airline ticket at a first price, and then have to spend even more money to fully realize the benefits, spending the additional money at the Duty Free shop.

The disconnect between the voucher itself being an invitation to make a sale and an actual sale and delivery of a duty free item illustrates the impropriety of the present rejection as applied to various claim limitations. For example, claim 1 recites:

in conjunction with said offer to sell said specific international travel ticket at said discounted price, requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier ... said merchant having arranged with the first passenger carrier for delivery of the least one duty free item to said customer during the travel associated with said specific international travel ticket

Appellant further notes Air France's "voucher" being an invitation for a secondary purchase necessarily fails to teach or suggest the recited "requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one duty free item."

It would not have been obvious to one having ordinary skill in the art to combine Air France and Walker, because, among other differences, the combination would be a dangerously deceptive trade practice of misleading customers about the true costs of the “offer.” This is in direct contradiction to the expressly recited limitations claimed herein.

In ¶ 10 in the Response to Arguments section beginning on Page 6 of the May 20, 2009 Office Action, the Examiner cites to the well-understood holding of *In re Merck & Co.*, 800 F.2d 1029, 231 USPQ 375 (Fed.Cir.1986) for the position that Appellant cannot overcome the obviousness rejection by point to the failures of a single reference.

Appellant respectfully submits the recitation to *In re Merck* is misleading and improper because the rejection of the pending claims is predicated on the generalized and vague language of the Air France article, with significant (and improper) reliance on the concept of “Official Notice.” The above-position indicates the fatal failures of the Air France article as being applied to the present claims, in combination with the additional details of the obviousness rejection. Stated another way, one of skill in the art would never have generated the present invention by combining the Air France article with the Walker reference because the failures of the Air France article to support basic claim elements would leave the skilled artisan unable to have the claimed method recited herein.

C. Examiner’s Official Notice overlooks the exact claim language recited herein

Beginning on the final paragraph of page 3 of the September 11, 2008 Office Action extending on to page 4, the Examiner improperly paints too broad of a stroke in asserting the “Official Notice” reasoning for supporting the present rejection.

In claim 1, by way of example, Appellant previously amended the claim to recite:

...said merchant having arranged with the first passenger carrier for delivery of the at least one specific duty free item to said customer during the travel associated with said specific international travel ticket without the merchant being required to pay at least a portion of a concession fee otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items.

In supporting this rejection, the Examiner maintains the same Walker / Air France combination and simply adds an “Official Notice” statement. Appellant strenuously objects.

To avoid any confusion, Appellant notes that the Examiner states:

Official Notice is taken that it is old and well known for merchants and the like to negotiate an agreement with a manufacturer, host, provider of a goods and service and to pass all or some of the savings that result from said agreement to the customer. For example, Costco ® is a wholesaler corporation which buys in bulk at a discount and passes some of the savings to their members. It would have been obvious in the combination of Walker and Air France to have included the teachings of the well known business method of passing on some or all of the savings negotiated to the customers in order to provide the customer with discount and hopefully increase sale.

As understood, the Examiner makes the assertion that the basic concept of a buying in bulk and passing bulk savings to the customer is the same thing as the recited limitation quoted above. Appellant respectfully disagrees.

The Examiner’s Official Notice and supporting statement (quoted above) overlooks the exact claim language. Appellant does not claim a bulk purchase or a negotiated agreement with a manufacturer and the passing of those savings to customers. Rather, the exact claim language recites “said merchant having arranged with the first passenger carrier for delivery of ... the duty free item to said customer ... without the merchant being required to pay at least a portion of a concession fee.” Moreover, the claimed “concession fee” is a fee that is “otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items.”

The notion of bulk sales and passing savings to customers is completely inconsistent with the merchant having an arrangement for duty free item delivery without the merchant being required to pay a concession fee. First off, the Examiner overlooks the claimed “concession fee” relating to a duty free item delivery. Secondly, the Examiner makes an illogical connection between a bulk rate or a saving being passed on to the customer and the merchant not “being required to pay at least a portion of a concession fee.” The claims do not recite any passage of savings to customers.

The Examiner’s assertions supporting the present rejection ignore the **exact language of the claims**. Again, as noted with respect to the position above, the Examiner misreads the claims and assumes elements not within the claims themselves. In supporting the assertion that the Costco® business model renders the claim obvious, the Examiner assumes that a single merchant negotiates a discount from a supplier and passes savings on to clients based on the bulk purchase. The claim recites “requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item,” where the offer to sell the international travel ticket is offered “at a discount price.” There is no support for the Examiner’s assertion that the “savings” of the “discounted” price are based on the “concession fee.” Rather, the recited claim expressly notes a relationship that allows “the merchant to sell the specific international ticket at the discount price.” Stated another way, the claims recite the setting of the discount price of the travel ticket based on the dollar value of the duty free item, and concession fee portion not being paid defines a sufficiency level that allows for the sale of the ticket.

Appellant further notes the applicability of the above-offered position in Section B above as applicable to the exact claim language of: “wherein said merchant determines the discount price of said specific international travel ticket based at least in part on a dollar value of one or more duty free items which **are or must be purchased** from the merchant” (emphasis added). The Examiner’s logic and “Official Notice,” in conjunction the teachings of Air France fail to address the exact claim language noting that the discount price is “based at least in part on a dollar value of one or more duty free items which are or must be purchased.” The Air France teaching of a voucher is only an invitation for the sale of an item. The cost of the Air France ticket is totally unrelated to any actual duty free item purchase, rather when purchasing the Air France ticket, you get a voucher that **can** be used for the purchase of whatever duty free item the traveler chooses, **if** the traveler chooses to actually even purchase anything, i.e. the traveler can skip the duty free shop altogether, which is entirely contrary to the exact claim language recited herein.

D. The “voucher” of the Air France disclosure is not tied to any specific international travel ticket

For further illustration of the irreconcilable differences between the Air France system and the claimed invention, it is noted that Air France “voucher” is not tied to the present itinerary associated with an international travel ticket.

Air France explicitly notes that with the purchase of a round-trip economy-class fare of \$428, the passenger receives a discount voucher good in the duty free shops at Charles de Gaulle airport. The exact language of Air France is that a person receives a voucher and as noted above in section II, the voucher is not a duty free item, but rather an

enticement **to make** a purchase of a duty free item, e.g. the passenger having to make a complete, separate and distinct financial transaction.

The disconnect between the voucher itself being an invitation to make a sale and an actual sale tied to a specific international travel ticket illustrates the impropriety of the present rejection as applied to various claim limitations. Claim 1 recites:

in conjunction with said offer to sell said specific international travel ticket at said discounted price, requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier ... said merchant having arranged with the first passenger carrier for delivery of the least one duty free item to said customer during the travel associated with said specific international travel ticket

The discount voucher is not tied to a particular itinerary, for example the passenger is not required to purchase anything from the duty free shop at all, much less on that particular trip. This therefore fails to teach or suggest the delivery of the duty free item “to said customer during the travel associated with said specific international travel ticket.” The discount voucher is not associated with the international travel ticket, and as such Air France does not teach or suggest such limitation.

E. Examiner fails to make a prima facie case in support of the present rejection.

Appellant submits that the Examiner fails to make a prima facie case in support of the rejection for all of the claims 1-2, 4-5, 7-12, 14-15, 17-19, 85 and 96-102, 104-105 and 108.

As noted above, the Examiner dispatches the rejection of all pending claims based on the asserted obviousness combination of Walker with the Air France article and “official notice.” Appellant appreciates the latitude the Examiner is granted in postulating an “obviousness” rejection, especially in view of KSR v. Teleflex, 550 U.S.

398 (2007), but submit that the present rejection facially fails to support the prohibition of the patentability of the pending claims. Appellant notes the stated motivation and inventive concepts arising to the necessity of the present invention, including for example described in ¶¶ 17 and 18 of the published application, (Publication No. 2001/0037250.) These passages describe the operational problems of existing, prior art, systems having excess capacity of airline tickets and failing to sell those tickets, thereby losing potential revenue. The present invention provides a novel and non-obvious technique to both sell more duty free items and manage excess capacity of airline tickets. The Examiner's hindsight reconstruction of the disparate Walker and Air France references, as well as the blanket conclusionary support being embodied in "official notice," is not only improper for supporting the present rejection, but also a clear violation of not only the letter, but also the spirit of 35 U.S.C. s103 and the examination breadth granted under KSR v. Teleflex.

Appellant further notes that these claims cover approximately 10 pages in length, as noted in the Claims Appendix. The Examiner dispatches the final rejection of these claims in a mere 2 pages, without any specific reference to limitations beyond elements of claim 1.

Appellant, through various rounds of prosecution, is still unclear as to the requisite support for the final rejection of claims 2, 4-5, 7-12, 14-15, 17-19, 85, 96-102, 104-105 and 108. The failure of the Examiner to specifically address the claims is *ipso facto* a failure to make a prima facie case under the requisite legal examination guidelines.

F. Conclusion

Appellant respectfully submits that the rejection of independent claims 1, 11, and 96, as well as dependent claims 2, 4-5, 7-12, 14-15, 17-19, 85 and 96-102, 104-105 and 108, under 35 U.S.C. §103(a) are improper. Accordingly, Appellant asserts these claims are indeed patentable.

II. Claims 6 and 16 are improperly rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in combination with Air France in combination with Ong-Yeoh.

The rejection of claims 6 and 16 is improper for at least two reasons: (1) for at least the same reasons stated above regarding claims 1 and 11; and (2) Ong-Yeoh does not cure the Examiner-noted deficiencies of Walker in combination with Air France, rendering the final rejection fatally defective.

Claims 6 and 16 depend from Independent claims 1 and 11. Any depending claim from a nonobvious claim is also nonobvious. See, *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988)). Therefore, the rejection of these dependent claims is also improper for at least the same reasons stated above in §I.

III. Claim 20 is not properly rejected as the Examiner fails to give grounds of rejections.

Appellant asserts confusion regarding the status of claim 20. Claim 20 is listed on the Office Action Summary as being rejected (See, Disposition of Claims section, Box 6). Although, the May 20, 2009 Office Action does not provide an indication of any grounds for the rejection of the claim 20.

Appellant asserts confusion as to how claim 20 is denied patentability, with almost nine years of pendency, without even being given grounds for such just rejection.

Therefore, Appellant submits that (1) claim 20 is not properly rejection as the Examiner fails to give a grounds of rejection; and (2) the Examiner fails to make a prima facie showing in support of the holding of claim 20 being finally rejected.

Appellant notes that claim 20 depends ultimately from Independent claim 11. Any depending claim from a nonobvious claim is also nonobvious. See, *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596 (Fed. Cir. 1988)). Therefore, the rejection of this dependent claim is also improper for at least the same reasons stated above in §I.

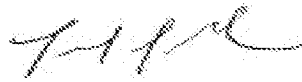
Conclusion

For the reasons set forth above, Appellant respectfully requests that the Board reverse the final rejections of the claims by the Examiner, including the rejection of the claims under 35 U.S.C. § 103(a) and indicate that claims 1-2, 4-12, 14-20, 85, 96-102, 104-105 and 108 are allowable.

Dated: August 31, 2009

THIS CORRESPONDENCE IS BEING SUBMITTED
ELECTRONICALLY THROUGH THE PATENT AND
TRADEMARK OFFICE EFS FILING SYSTEM ON
August 31, 2009.

Respectfully submitted,



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Claims Appendix

1. (Rejected) A method of selling international travel tickets in combination with duty free items from a single merchant, comprising the steps of:

offering to sell to a customer, over a computer network, a specific international travel ticket for travel with a first passenger carrier at a discounted price and one or more specific duty free items;

in conjunction with said offer to sell said specific international travel ticket at said discounted price, requiring said customer to select for purchase as part of a single transaction both the specific international travel ticket and at least one specific duty free item selected from a group of one or more specific duty free items, the at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier during the travel associated with the specific international travel ticket said merchant having arranged with the first passenger carrier for delivery of the at least one specific duty free item to said customer during the travel associated with said specific international travel ticket without the merchant being required to pay at least a portion of a concession fee otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items;

said merchant acknowledging said customer's decision to purchase said specific international travel ticket and said at least one specific duty free item, the acknowledgment being made over said computer network;

said merchant accepting payment over said computer network from said customer for said specific international travel ticket and said specific duty free item;

said merchant delivering said specific international travel ticket to said customer; and

said merchant advising said customer of the method of delivery of said specific duty free item to said customer, said method of delivery being connected to said customer engaging in the international travel associated with said specific international travel ticket;

wherein said merchant determines the discounted price of said specific international travel ticket based at least in part on a dollar value of one or more duty free items which are or must be purchased from the merchant such that the portion of the concession fee not paid by the merchant on the dollar value is sufficient to allow the merchant to sell the specific international ticket at the discounted price.

2. (Rejected) The method of claim 1, wherein said step of offering to sell said specific international travel ticket comprises offering to sell one or more of a plurality of specific international travel tickets which differ in at least one of their itineraries and destinations.

3. (Cancelled)

4. (Rejected) The method of claim 1, wherein the members of said group each have a predetermined maximum assigned value which is dependent on the price of said specific international travel ticket selected for purchase by said customer.

5. (Rejected) The method of claim 4, further comprising the steps of said customer selecting at least one specific international travel ticket from among said plurality of specific international travel tickets and selecting at least one specific duty free item from said group of specific duty free items.

6. (Rejected) The method of claim 1, wherein said step of advising said customer of the method of delivery of said at least one specific duty free item comprises advising said customer that said at least one specific duty free item will be delivered to said customer at one of an international port of departure, an international port of arrival and during international travel, whereby said at least one specific duty free item qualifies for duty free status.

7. (Rejected) The method of claim 5, wherein said step of said customer selecting said at least one specific international travel ticket further comprises the step of said customer viewing itinerary and pricing information concerning said selection of specific international travel tickets by accessing a first web site over said computer network.

8. (Rejected) The method of claim 7, wherein said step of said customer selecting said at least one specific duty free item further comprises the step of said customer viewing descriptive information concerning said selection of specific duty free items by accessing a second web site over said computer network.

9. (Rejected) The method of claim 8, further comprising the step of said customer making payment for said at least one specific international travel ticket by providing credit card information to a first remote computer over said computer network.

10. (Rejected) The method of claim 9, further comprising the step of said customer providing at least one of an address, phone number, email address and a passport number to a second remote computer over said computer network.

11. (Rejected) A method of selling duty free items in combination with international travel tickets from a single merchant, comprising:

offering to sell to a customer, over a computer network, at least one of a plurality of specific duty free items at an offering price;

in conjunction with said offer to sell said at least one specific duty free item at said offering price, requiring said customer to select for purchase as part of a single transaction both the specific duty free item and at least one specific international travel ticket to be selected from the group of one or more specific international travel tickets, the at least one specific duty free item to be delivered to the customer at or near an exit point or on board the passenger carrier during the travel associated with said at least one-specific international travel ticket said merchant having arranged with the first passenger carrier for delivery of the at least one specific duty free item to said customer during the travel associated with said at least one specific international travel ticket without the merchant being required to pay at least a portion of a concession fee otherwise charged by the passenger carrier to merchants for selling or delivering such duty free items;

said merchant acknowledging said customer's decision to purchase said at least one specific duty free item and said at least one specific international travel ticket, the acknowledgment being made over said computer network;

said merchant accepting payment over said computer network from said customer for said at least one specific duty free item;

said merchant advising said customer of the method of delivery of said at least one specific duty free item to said customer; said method of delivery being connected to said customer engaging in the international travel associated with said at least one specific international travel ticket; and

delivering said at least one specific international travel ticket to said customer;

wherein said merchant determines the offering price of said at least one specific duty free item such that the portion of the concession fee not paid by the merchant on the offering price is sufficient to allow the merchant to sell the specific international travel ticket.

12. (Rejected) The method of claim 11, wherein said step of offering to sell said at least one specific duty free item comprises offering to sell one or more of a plurality of specific duty free items.

13. (Canceled)

14. (Rejected) The method of claim 12, wherein the members of said group each have a predetermined maximum assigned value which is dependent on the price of said at least one specific duty free item selected for purchase by said customer.

15. (Rejected) The method of claim 14, further comprising the steps of said customer selecting at least one specific duty free item from among said plurality of specific duty free items and selecting at least one specific international travel ticket from said group of specific international travel tickets.

16. (Rejected) The method of claim 11, wherein said step of advising said

customer of the method of delivery of said at least one specific duty free item comprises advising said customer that said at least one specific duty free item will be delivered to said customer at one of an international port of departure, an international port of arrival and during international travel, whereby said at least one specific duty free item qualifies for duty free status.

17. (Rejected) The method of claim 15, wherein said step of said customer selecting said at least one specific duty free item further comprises the step of said customer viewing descriptive and pricing information concerning said selection of specific duty free items by accessing a first web site over said computer network.

18. (Rejected) The method of claim 17, wherein said step of said customer selecting said at least one specific international travel ticket further comprises the step of said customer viewing itinerary information concerning said selection of specific international travel tickets by accessing a second web site over said computer network.

19. (Rejected) The method of claim 18, further comprising the step of said customer making payment for said at least one specific duty free item by providing credit card information to a first remote computer over said computer network.

20. (Rejected) The method of claim 19, further comprising the step of said customer providing at least one of an address, phone number, email address and a passport number to a second remote computer over said computer network.

21-84 (canceled)

85. (Rejected) The method of claim 1, wherein offering to sell to a customer at least one specific international travel ticket comprises offering to sell at least

one specific air travel ticket.

86. (Withdrawn) A computer implemented method performed by a merchant for offering a combination of an international travel ticket and a duty free item to a consumer, the method comprising:

purchasing a plurality of international travel tickets and a plurality of duty free items from third parties;

computing prices for combinations, each combination including one or more international travel tickets and one or more duty free items;

offering the combinations to a consumer for purchase;

in response to a consumer selecting a given combination, selling the one or more international travel tickets and the one or more duty free items in the selected combination to the consumer in a single transaction; and

arranging for delivery of the one or more duty free items in the selected combination to the consumer in association with the consumer's travel using the one or more international travel tickets in the selected combination.

87. (withdrawn) The method of claim 86, wherein purchasing international travel tickets comprises conditionally purchasing the international travel tickets.

88. (withdrawn) The method of claim 86, wherein purchasing duty free items comprises conditionally purchasing the duty free items.

89. (withdrawn) The method of claim 86, wherein purchasing international travel tickets comprises purchasing surplus international travel tickets.

90. (withdrawn) The method of claim 86, wherein purchasing

international travel tickets comprises contracting with an airline to purchase a minimum dollar amount of tickets and purchasing one or more international travel tickets in a selected combination after the consumer has selected the combination.

91. (withdrawn) The method of claim 86, wherein computing prices for combinations comprises computing prices based on costs of the international travel tickets and duty free items to the merchant.

92. (withdrawn) The method of claim 91, wherein computing prices comprises computing a price for a given combination to ensure recovery of the cost of the international travel ticket in the price for the duty free item.

93. (withdrawn) The method of claim 86, wherein offering the combinations comprises allowing the consumer to first select an international travel ticket or duty free item at a first specified price and allowing the consumer to select the other of an international travel ticket or duty free item at a second specified price, and wherein computing the prices comprises adding the first and second prices.

94. (withdrawn) The method of claim 86, wherein the international travel tickets comprise air travel tickets.

95 (withdrawn) The method of claim 86, wherein offering the combinations to the consumer comprises allowing the consumer to first select either a specific international travel ticket or a specific duty free item and then select a specific duty free item or a specific international travel ticket, respectively, that forms part of a given one of the combinations.

96. (Rejected) A computer implemented method for offering a combination of an international travel ticket and a duty free item to a consumer, the

method comprising:

offering a plurality of international travel tickets and a plurality of duty free items to a customer;

allowing the customer to select at least one of the international travel tickets for travel on a first passenger carrier or at least one of the duty free items for purchase;

if the customer has selected at least one of the international travel tickets, requiring the customer to select at least one of the duty free items to obtain in combination with the selected international travel ticket at a first price;

if the customer has selected at least one of the duty free items, requiring the customer to select at least one of the international travel tickets to obtain in combination with the selected duty free item at a second price;

selling the at least one selected international travel tickets and the at least one selected duty free items to the customer in a single transaction; and

arranging for delivery of the at least one selected duty free items to the customer in association with the customer's travel using the at least one selected international travel tickets at or near an exit point or on board the first passenger carrier;

wherein the first price and the second price are each determined such that at least a portion of a concession fee otherwise charged by the first passenger carrier to merchants for selling or delivering such duty free items is not included in the first and second prices.

97. (Rejected) The method of claim 96, wherein requiring the customer to select at least one of the duty free items comprises matching one or more of the

plurality of duty free items to the at least one selected international travel ticket and offering the matching one or more duty free items to the customer.

98. (Rejected) The method of claim 97, wherein matching comprises matching one or more duty free items to the at least one selected international travel ticket based on a price of the international travel ticket.

99. (Rejected) The method of claim 96, wherein requiring the customer to select at least one of the international travel tickets comprises matching one or more of the plurality of international travel tickets to the at least one selected duty free item and offering the matching one or more international travel tickets to the customer.

100. (Rejected) The method of claim 99, wherein matching comprises matching one or more international travel tickets to the at least one selected duty free item based on a price of the selected duty free item.

101. (Rejected) The method of claim 96, wherein offering a plurality of international travel tickets and a plurality of duty free items to a customer comprises purchasing the international travel tickets and the duty free items from third parties and offering the purchased international travel tickets and duty free items to the customer.

102. (Rejected) The method of claim 101, wherein purchasing the international travel tickets and the duty free items from third parties comprises conditionally purchasing the international travel tickets and the duty free items from third parties before offering them to the customer.

103. (cancelled)

104. (Rejected) The method of claim 96, wherein offering a plurality of international travel tickets comprises offering air travel tickets.

105. (Rejected) The method of claim 1, wherein requiring the customer to select at least one specific duty free item comprises advising the customer of a dollar value of duty free merchandise which must be purchased to purchase the at least one specific international travel ticket at the offering price.

106. – 107. (canceled)

108. (Rejected) The method of claim 1, wherein requiring the customer to select at least one specific duty free item comprises advising the customer of a dollar value of duty free merchandise which must be purchased to purchase the at least one specific international travel ticket at no additional cost to the dollar value of duty free merchandise.

109. -110. (Canceled)

Evidence Appendix

No evidence has been submitted or relied upon in the instant appeal.

Related Proceedings Appendix

There are no related proceedings which are related to or would have a bearing on the instant appeal.